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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,240	03/30/2001	Frank B. Gertler	M0656/7064(HCL)	6318

7590 12/31/2002

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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT PAPER NUMBER

1636

DATE MAILED: 12/31/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,240

Applicant(s)

GERTLER ET AL.

Examiner

Terry A. McKelvey

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17, 25-28, 37, 45, 52, 56, 59, 65, 71, 76, 82 and 83 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_ is/are objected to.

8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-17,25-28,37,45,52,56,59,65,71,76,82 and 83.

DETAILED ACTION

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to method for preventing mammalian cell migration by inducing a functional Ena/VASP protein, classified in class 435, subclass 375.
- II. Claim 17, drawn to method for preventing tumor cell metastasis by administering a plasma membrane targeting compound, classified in class 514, subclass 1+.
- III. Claim 25, drawn to method of identifying a therapeutic Ena/VASP activator, by measuring cell migration, classified in class 435, subclass 29.
- IV. Claims 26-27, drawn to method for identifying a therapeutic Ena/VASP activator, by measuring location of endogenous Ena/VASP, classified in class 435, subclass 29.
- V. Claim 28, drawn to method for promoting cell migration by depleting a mammalian cell of a functional Ena/VASP protein, classified in class 435, subclass 375.

- VI. Claim 37, drawn to method for promoting tissue generation by contacting cells with an Ena/VASP inhibitor, classified in class 514, subclass 1+.
- VII. Claim 45, drawn to method for preventing neurodegeneration comprising administering to a subject an Ena/VASP inhibitor, classified in class 514, subclass 1+.
- VIII. Claim 52, drawn to method for enhancing learning and memory comprising administering to a subject an Ena/VASP inhibitor, classified in class 514, subclass 1+.
- IX. Claim 56, drawn to method for disrupting learning and memory comprising administering to a subject an Ena/VASP activator, classified in class 514, subclass 1+.
- X. Claim 59, drawn to composition comprising an Ena/VASP inhibitor, classified in class 514, subclass 1+.
- XI. Claim 65, drawn to composition comprising an Ena/VASP activator, classified in class 514, subclass 1+.
- XII. Claim 71, drawn to modified cell comprising an Ena/VASP negative cell, classified in class 435, subclass 325.

- XIII. Claim 75, drawn to method for identifying a therapeutic compound, classified in class 435, subclass 29.
- XIV. Claim 76, drawn to compound comprising an actin binding domain and a cell motility domain, classified in class 514, subclass 1+.
- XV. Claim 82, drawn to modified Ena/VASP protein, classified in class 530, subclass 350.
- XVI. Claim 83, drawn to method for identifying a therapeutic compound by screening compounds for the ability to interact with an actin barbed end, classified in class 435, subclass 7.8.

Group I is comprised of multiple inventions which are the methods drawn to use of different and distinct molecules which are chemically, biologically, and structurally distinct from each other, do not render obvious each other and thus methods drawn to the use of the distinct molecules are patentably distinct from each other. If Group I is elected, applicants must elect a single invention which is the method drawn to the use of one specific molecule to which the claims will be restricted.

Claims 1-2 link inventions drawn to the use of different activators. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, claims 1-2. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application.

Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-IX, XIII, and XVI are biologically and functionally different and distinct from each other and thus

one does not render the other obvious. The methods of Groups I-IX, XIII, and XVI comprise steps which are not required for or present in the methods of the other groups. The end result of the methods are different. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

The products of Groups X-XII and XIV-XV are chemically, biologically, structurally, and functionally distinct from each other and thus one does not render the other obvious. The product of one group is not required to produce the product of any of the other groups because the other products can be made synthetically or by self-replication. Therefore, the inventions of these groups are capable of supporting separate patents.

Inventions of Group X and Groups VI-VIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a materially different process, as evidenced by the distinct inventions of Groups VI-VIII.



Inventions of Group XI and Groups I and IX are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a materially different process, as evidenced by the distinct inventions of Groups I and IX.

Inventions of Group XII and Groups XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a materially different process, replication of a vector in the cell.

Except for the specific relationships described above, inventions of Groups X-XII, XIV-XV and Groups I-IX, XIII, and XVI are biologically and functionally different and distinct from each other and thus one does not render the other obvious. Each of the product groups, Groups X-XII, XIV-XV, are not

required for or produced in the method groups, Groups I-IX, XIII, and XVI. Thus, the operation, function and effects of the products are completely different and distinct from the operation, function and effects of the methods. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the non-patent search required for each of the groups is not co-extensive with each other because different materially different elements are required to be searched for each group, thus causing an undue burden to search together, restriction for examination purposes as indicated is proper.

A telephone call was made to Helen Lockhart on 8/19/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in

compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Conclusion**

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be

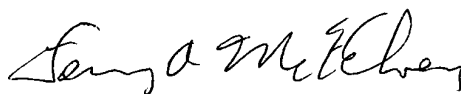
Application/Control Number: 09/823,240  
Art Unit: 1636

Page 10

responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636

December 29, 2002